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Rejection Under §112, Second Paragraph

The Examiner has rejected Claims 1-19 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicants regard as the invention. The Examiner states that the recitation "active side" in Claims 1 and 12, and the recitation of "adapted to" in Claims 10, 13, and 14 is vague and indefinite. (1/16/03 Office Action, Pg. 2)

The test for definiteness is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain the meaning of the terms in light of the specification, 35 U.S.C. §112 second paragraph is satisfied. MPEP §2173.02

Applicants assert that a person of ordinary skill would understand the scope of the invention as claimed and understand the phrase "active side" to mean the side of a storage wrap that is adhered to the desired surface. The "active side" is described in Claims 1 and 12 as well as the Specification, page 9.

Applicants also assert that a person of ordinary skill would understand the scope of the invention as claimed and understand the phrase "adapted to" means that changes can be made to the wrap to achieve different affects. Possible changes that can be made to adapt the storage wrap, and affects that may result, are adequately described in Claims 10, 13, and 14, as well as in the specification at page 10, lines 11-13, and, Page 12, Lines 7-13.

Claims 1-19 are not indefinite, and Applicants assert that the invention is sufficiently described in the claims so that a person of ordinary skill in the art would understand the scope of the invention. Thus, the rejection of the pending claim under §112, second paragraph is improper and should be withdrawn.

Rejection under 35 U.S.C. §103(a)

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,965,235 issued to McGuire ("McGuire"). Applicants respectfully traverse this rejection.

McGuire relates to a three-dimensional sheet material having a plurality of protrusions in an amorphous pattern. A preferred embodiment of McGuire is the three-dimensional sheet has a layer of adhesive in the depressions between the protrusions having a thickness from 0.0005 inch to 0.002 inch, preferably 0.001 inch. (McGuire, Col. 17, Lines 40-45.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a

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reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Examiner. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-site Corp. v. VSI Int'l Inc., 174 F3d. 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Also, it is well settled that an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references "teach away" from the invention. Micro Chemical, Inc. v. Great Plains Chemical co. Inc., 41 USPQ2d 1238 (Fed. Cir. 1997).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness as no suggestion or motivation exists to modify the reference to include the inventive thickness of about 0.00001 to about 0.0002 inch of adhesive composition. The reference cited does not suggest a reasonable expectation of success at this inventive thickness of adhesive composition. Finally, not all the claim limitations are included in the prior art reference. In fact, the reference cited by the Examiner teaches away from the present invention by teaching an adhesive thicknesses over 0.0005 inch, and preferably 0.001 inch, five times the highest claim thickness of the present claims.

{ The Examiner rejects the inventive storage wrap, stating that McGuire teaches a storage wrap with an "adhesive coating composition having a thickness less than the height of the non-adherent protrusions." However, the Examiner also admits that "McGuire fails to teach the specific ranges for the thickness as recited in claims 1 and 2." (1/16/03 Office Action, Page 3.) The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the adhesive coating composition with the specific ranges of thickness as recited in Claims 1 and 2, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absent of showing unexpected results." (1/16/03 Office Action, Page 3, citing In re Boesch and Slaney, 205 USPQ, 215 (CCPA 1980)).

{ Applicants respectfully submit that the Examiner is citing an inapplicable case. The decision in In re Boesch and Slaney, involves overlapping inventions, where "each of the ranges of constituents in appellants' claimed alloys overlaps ranges disclosed" by the cited prior art references. Id. at 275. The Court stated "considering, also, that the composition requirements of the claims and the cited references overlap, we agree...that the prior art would have suggested the kind of experimentation necessary to achieve the claimed composition. This accords with the rule that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." Id. at 276. Examiner's statement of the law of In re Boesch and Slaney, is not accurate, the Court has held that where "each of the ranges of constituents" is disclosed the inventor must show

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surprising and unexpected results, not "where the general conditions of the claim are disclosed." See *Id.* at 275. (1/16/03 Office Action, Page 3) Applicants assert that surprising and unexpected results need not be shown until each of the claimed ranges of the constituents of the invention are disclosed by the art. The Examiner has clearly stated that one of the claimed ranges is not disclosed. Therefore, Applicants are not required to show surprising and unexpected results to establish that the invention would not have been obvious.

Applicants submit that Micro Chemical, Inc. better expressed the law applicable to the present situation. McGuire's teaching of adhesive thicknesses greater than 0.0005 inch, and preferably equal to 0.001 inch, clearly teaches away from the use of adhesive thicknesses ranging from about 0.00001 inch to about 0.0002 inch as required by the claims of the present application.

Additionally, Applicants assert that routine experimentation by one of ordinary skill in the art would not result in the ranges of thickness for the adhesive coating, as nothing in the art suggests using the claimed ranges of adhesive. "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the references to do so." In re Mills, 916 F.2d 680, 682; 16 USPQ 1430 (Fed. Cir. 1990). The inventive adhesive composition coating has a thickness from about 0.0001 inches to about 0.0002 inches. The adhesive composition disclosed in McGuire has a thickness from about 0.0005 inches to about .001 inches. The Examiner has failed to point to any teaching in McGuire that suggests the use of an adhesive composition of lesser thickness than stated in the disclosed range. Additionally, the Examiner has not pointed to a teaching which suggests a reasonable expectation of success resulting from using the inventive adhesive composition thickness.

This is not a selection invention as defined in In re Boesch and Slaney, the claims and the references do not overlap. As stated by the Examiner "McGuire fails to teach the specific ranges or the thickness as recited in Claims 1 and 2," therefore, the cited art does not teach all elements of the claimed invention and the rejection of Claims 1-15 is improper and should be withdrawn.]

The Examiner rejects Claims 16-20 stating that "process limitations are given little or no patentable weight." (1/16/03 Office Action, Page 3) The Examiner states that "when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art." (1/16/03 Office Action, Page 4) The Examiner states that "the limitations in claims 16-20 are methods of production and therefore do not determine the patentability of the product itself." (1/16/03 Office Action, Page 4)

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"A product by process claim, which is a product claim that defines the claimed product in terms of the process by which it is made is proper." In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1983), §2173.05(p). The inventive wrap, as defined by Claim 16, is produced by a process which includes the addition of an adhesive coating with a thickness of from about 0.00001 inches (0.00025mm) to about 0.0002 inches (0.0051mm). "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." In re Donald Thorpe, 777 F.2d 695, 697 (1985), 227 USPQ 964. The inventive product, as defined in Claim 16, is prepared by a process which includes the addition of an inventive thickness of adhesive coating. Therefore, the resulting product includes the inventive level of adhesive coating, and would not have been obvious to one of ordinary skill in the art in light of McGuire for the reason set forth above; the product from the product-by-process claim is not the same or obvious from a product of the prior art. Applicants assert that the Examiner has failed to establish a prima facie case of obviousness, and therefore, the rejection of Claims 16-20 under 35 U.S.C. §103 is improper and should be withdrawn.

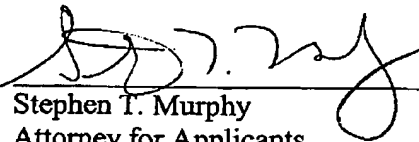
CONCLUSION

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §§ 112, second paragraph, and 103(a) with respect to pending Claims 1-20. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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